

REMARKS

Claims 17-19 are pending in the application. Claims 17-19 have been rejected. Reconsideration and withdrawal of the rejections set forth in the Office Action dated May 6, 2004 are respectfully requested in view of the following remarks which address the Examiner's comments in the Office Action. The applicant petitions the Commissioner for a 1-month extension of time: a separate petition accompanies this response.

I. Rejections under 35 U.S.C. §102

Claims 17 and 18 were rejected under 35 U.S.C. § 102(e) as allegedly anticipated by United States Patent No. 5,632,772 to Alcime *et al.* ("Alcime"). Applicants respectfully traverse this rejection. Without acquiescing to each or any reason alleged by the Examiner for this rejection, Applicants respectfully submit that Alcime cannot anticipate claims 17 and 18 because it does not describe each and every element of the claims and "a finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device." *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349, 48 U.S.P.Q.2d 1225 (Fed. Cir. 1998). See also, *Motorola Inc. v. Interdigital Technology Corp.*, 121 F.3d 1461, 1473, 43 U.S.P.Q.2d 1481 (Fed. Cir. 1997) ("For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art. ... Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there.")

As an example of the shortcomings of Alcime, the reference nowhere teaches (or suggests) a "coating ... for enhancing endothelial cell growth" as recited in all claims currently pending (*i.e.*, the "coating" is described in both independent claims 17 and 20 and therefore also in all dependent claims). The Examiner alleges that Alcime teaches a "coating" as described in the claims and the Examiner points to column 13, lines 56-61 in Alcime where the reference states: "The surface treatments can also provide for the elution or immobilization of drugs such as heparin, antiplatelet agents, antiplatelet-

derived growth factors, antibiotics, steroids, and the like. Additionally, the coating and/or liner can be loaded with drugs such as those discussed herein, as well as lytic agents in order to provide local drug therapy." Applicants respectfully submit that the disclosure in Alcime relied on by the Examiner does not teach or suggest a "coating ... for enhancing endothelial cell growth" and that nowhere in Alcime is there any teaching or suggestion of such a "coating".

Applicants point out that Alcime can also not anticipate the subject invention through inherency because "[a] claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present." *Akamai Technologies, Inc. v. Cable & Wireless Internet Services, Inc.*, 344 F.3d 1186, 1192, 68 U.S.P.Q.2d 1186 (Fed. Cir. 2003). Applicants respectfully submit that the "coating" of the subject invention is not taught (or suggested) in Alcime and is also not "necessarily present" in that reference. *Akamai Technologies, supra*.

Applicants respectfully request withdrawal of this rejection in view of the above.

II. Rejections under 35 U.S.C. §103

Claim 19 was rejected under 35 U.S.C. § 103 as allegedly obvious over Alcime, in view of United States Patent No. 6,071,305 to Brown *et al.* ("Brown") and further in view of United States Patent No. 5,958,428 to Bhatnagar ("Bhatnagar"). Applicants respectfully traverse this rejection. Without acquiescing to each or any reason alleged by the Examiner for this rejection, Applicants respectfully submit that Alcime, Brown and Bhatnagar, alone or in combination, cannot render the subject invention obvious because these references do not teach or suggest each element of the claimed invention and further because there is not suggestion to combine these three references.

An example of the shortcomings of the cited references is their lack of teaching or suggestion of a "coating ... for enhancing endothelial cell growth" as recited in all claims currently pending. The shortcomings of Alcime exemplified above, cannot be overcome through Brown and Bhatnagar. Applicants respectfully submit that the Examiner's allegations with respect to the Brown reference are not supported by the Brown reference. For example, Brown discusses a stent with a cavity or interior that

contains an agent for delivery (e.g., column 2, lines 48-52). Nowhere does Brown teach or suggest a “coating” as recited in the subject invention. Finally, Bhatnagar is not concerned with any device like the subject invention but discusses cell binding compounds and their delivery through a matrix. Thus, none of the cited references teaches or suggests the devices of the subject invention.

Applicants respectfully submit that a rejection of the subject invention over Alcime, Brown and Bhatnagar is also improper as the suggestion to combine these references required for a rejection under section 103 is lacking. “When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. ... ‘The factual inquiry whether to combine references must be thorough and searching.’ ... It must be based on objective evidence of record.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002) (citations omitted). It has also been held that “the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.” *In re Rouffet*, 149 F.3d 1350, 1358, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). Therefore, “a rejection cannot be predicated on the mere identification in [the references] of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313 (Fed. Cir. 2000).

Applicants submit that, in addition to the references’ deficient teachings, there is no suggestion to combine the references and no evidence supporting such a combination has been made of record as required by Federal Circuit case law.

Applicants respectfully request withdrawal of this rejection in view of the above.

III. Conclusion

Applicants respectfully submit that pending claims 17-32 are in condition for immediate allowance. The undersigned invites the Examiner to call (650) 838-4382 with any questions or comments. The Commissioner is hereby authorized and requested to charge any deficiency in fees herein to Deposit Account No. 50-2207.

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Respectfully submitted,
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